

REMARKS

I. Status of Claims

Claims 1-19 are original claims present in Patent No. 5,128,520 which are currently in Patent No. RE35,117. Thus Claims 1-19 have been cancelled herein without prejudice since those claims are already in RE35,117.

Claims 20-29 are pending in the present application. New Claims 30-43 have been added by this amendment.

II. Amendments to the Specification and Claims

The claim of priority paragraph on page 2 of the specification has been amended into a better grammatical format that the priority applications, as well as the present application, are all reissues of Patent No. 5,128,520.

Claim 29 has been amended to correct for a typographical error in line 7 thereof deleting "a" before "generating a second scanning beam".

It is submitted that the amendment to the specification and claims add no new matter.

### III. Rejection Based on Defective Reissue Declaration

The claims have been rejected based upon a defective reissue declaration as to a typographical error referring to an incorrect parent application. A supplemental reissue declaration will be submitted to correct for the error. It is requested that the submission of the supplemental reissue declaration be deferred until allowance. See, MPEP § 1444, pg 1400-45.

### IV. Surrender of the Original Patent

The original patent 5,128,520 was surrendered during the prosecution of RE35,117 (grandparent to the present application). Since the original patent has already been surrendered, a subsequent surrender is not required.

### V. Objections to Specification and Section 112 Rejection

The Specification has been objected to as failing to provide support for the claimed subject matter of the focal distances of the first and second scan patterns being different.

Claims 25-27, 29 have been rejected under 35 U.S.C. 112, first paragraph, as containing subject matter (different focal distances for the first and second scan patterns) not specifically found in

the specification. This objection/rejection is respectfully traversed.

Support for the subject matter of Claims 25-27 and 29 was set forth in the Status of Claims and Support For Claim Changes filed 12/20/2000 with the present application:

Support for Claims 25-27: Fig. 3A, page 6, col. 8, lines 45-68; Figs. 6-7, page 7, col. 10, lines 26-40;

Support for Claim 29: Figs 3A-3B; pages 6-7, col. 8, line 45 through col. 9, line 30; Figs. 6-7, page 8, col. 10, lines 26-40.

Providing some further explanation, in a preferred embodiment referring to Fig. 3A, an auxiliary lens 86 is provided in the path of the scan beam producing the scan line 88. The auxiliary lens 86 changes the focus of the outgoing beam (and the return light) to be different for scanning through the vertical window 78 than through the horizontal window of scanner 67 (the horizontal window 70 being shown in Fig. 3). Since the second scan pattern passing through the vertical window 78 passes through the lens 86, the second scan pattern is focused at a different distance than first scan pattern passing through the horizontal window 70 that does not pass through the lens 86.

Thus it is submitted that Claims 25-27 and 29 are supported by the application as originally filed and by the prior parent

applications. It is requested that the objection to the specification and the § 112 rejection be removed.

VI. Section 102/103 Rejections

Claims 20-23 are rejected under 35 U.S.C. 102(g) over Katoh '930; and Claims 24 and 28 are rejected under 35 U.S.C. 103 over Nickl '732. These rejections are respectfully traversed. Each of the claims will be discussed in turn.

A. Claims 20-23

In the Information Disclosure Statement filed 12/20/2000 with the present application, at pages 4-5, Notice of Claims in Other Patent [37 CFR 1.607(c); MPEP 2001.06(6)] was provided by way of the chart, reproduced below, identifying certain claims in the present application copied from claims in Katoh U.S. 5,693,930:

Claims In the Present Application	Claims in U.S. Patent No. 5,693,930
20	1
21	23
22	34
23	37

The present application has an effective priority date of 8/11/1989 which is before the 7/9/1993 priority date of the Katoh '930 patent. Moreover, as to Claims 20-23, the requirements of 35 U.S.C. 135(b) are met because Claims 20-23 were previously presented in parent application 08/570,626 as claims 115-118 by the amendment filed 10/26/1998 (i.e. within one year of the 12/2/1997 issue date of the Katoh '930 patent).

Thus it is respectfully submitted that §102(g) rejection should be removed.

B. Claims 24 and 28

Nickl '732 discloses (Fig. 1) a scanner having two windows 20, 22, each window being arranged in the same, generally vertical, plane. As shown in Fig. 2, the scanner 10 generates a scan pattern out of each window: scan line set 30 (parallel scan lines 30a-f) out of window 20; and scan line set 32 (parallel scan lines 32a-f) and scan line set 34 (parallel scan lines 34a-f) out of window 20.

Though the scan pattern of scan lines 30a-f are parallel (described in the Office Action as "a single orientation"), this scan pattern does not comprise a single scan line as in Claim 24 or Claim 28, and Nickl '732 provides no disclosure to modify the pattern as such. Indeed, Nickl '732 would teach away as to this

supermarket fixed scanner in which products are moved through the scan volume. The Nickl '732 scan patterns are designed for the purpose of "locating and detecting the code indicated on label 28." Col. 3 lines 11-13. The idea for such a fixed scanner is to be able to scan a bar code on the item no matter what the orientation of the code the item is passed through the scan volume. In contrast, a single scan line as in Claim 24 or 28 would not locate and detect the code because a single scan line must be lined up to the bar code as well as oriented along the proper direction in order to scan the bar code. Thus Nickl '732 would teach away from such a modification/combination.

It is noted that there existed fixed scanners with an asterisk scan pattern, and handheld scanners with a single scan line pattern, but there is no suggestion (1) for a scanner with the first scan pattern comprises a plurality of intersecting scan lines and the second scan pattern comprises a single scan line as in Claim 24; or (2) a method of scanning comprised of generating a second scan pattern consisting of a single scan line and passing the second scan pattern out through the second surface area as in Claim 28. Only the present application describes any advantage for including a single scan line -- there is no motivation in the cited items for making the combination and modification suggested by the

Office Action to make the rejection.<sup>1/</sup> Thus it is submitted that a *prima facie* case of obviousness has not been made

Therefore it is submitted that Claims 24 and 28 are non-obvious over Nickl '732.

#### VII. Support for Claims Amendments

Support for newly added Claims 30-38 is set forth in the following:

Claim 30 -- Figs. 3, 3A-3B and pages 6-7, col. 8 line 16 through col. 9 line 30; Figs. 6-7 and page 7, col. 10 lines 26-40; pages 10-11, col. 15 line 33 to col. 18 line 2.

Claims 31-36 -- In addition to the above as to Claim 30, page 5, col. 5 line 56 to col. 6 line 52; page 11, col. 18 lines 34-40.

Claims 37-38 -- In addition to the above as to Claim 28, page 8, col. 11 lines 1-12.

---

<sup>1/</sup>See e.g., *In re Lee*, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002) "In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."; *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

Claim 39 -- Figs. 3, 3A-3B and pages 6-7, col. 8 line 16 through col. 9 line 30; Figs. 6-7 and page 7, col. 10 lines 26-40; pages 10-11, col. 15 line 33 to col. 18 line 2.

Claim 40 -- Figs. 3, 3A-3B and pages 6-7, col. 8 line 16 through col. 9 line 30; Figs. 6-7 and page 7, col. 10 lines 26-40; pages 10-11, col. 15 line 33 to col. 18 line 2.

Claims 41-43 -- In addition to the above as to Claim 30, page 5, col. 5 line 56 to col. 6 line 52; page 11, col. 18 lines 34-40.

VIII. New Claims 30-43

New Claim 30 is directed to a system for reading bar codes on redemption coupons and reading bar codes on items being purchased in a consumer transaction, comprising:

- a data reader including

- a housing having a first window oriented generally horizontally and a second window oriented generally vertically,

- a rotating scanning mechanism contained within the housing for producing a first scan pattern which is directed through the first window and a second scan pattern which is directed through the second window,

- collection optics and decoding software, wherein bar codes on redemption coupons and bar codes on items being purchased are read by scan patterns produced by the scanning mechanism;



wherein the system includes coupon validation logic which determines whether a redemption coupon being read by the data reader correlates to any of the items being purchased.

It is submitted that the items of record do not disclose or suggest such the combination as in Claims 30-36. Dependent Claims 31-35 provide further distinguishing limitations.

Claims 37-38 should be allowable in part as depending upon Claim 28. These claims provide further distinguishing features.

Claim 39 includes the limitations

a data reader including a housing having a first window oriented generally horizontally and a second window oriented generally vertically, a first scanning system, disposed in the housing, for producing a first scan pattern of a plurality of intersecting scan lines which is directed upwardly through the first window, a second scanning system, disposed in the housing, for producing a second scan pattern which is directed sidewardly through the second window, collection optics and decoding software; and

coupon validation logic which determines whether a redemption coupon being read by the data reader correlates to any of the items being purchased.

Claim 40 includes the limitations

a data reader including (a) a housing having a first window oriented generally horizontally and a second window

oriented generally vertically, wherein the data reader produces (1) a first scan pattern of a plurality of intersecting scan lines which is directed upwardly through the first window and (2) a second scan pattern which is directed sidewardly through the second window, and (b) collection optics; and

coupon validation logic which determines whether a redemption coupon being read by the data reader correlates to any of the items being purchased.

It is submitted that the items of record do not disclose or suggest such the combination as in Claims 39 or 40. Dependent Claims 41-43 provide further distinguishing limitations.

#### IX. Information Disclosure Statement


It is noted that an Information Disclosure Statement, including Form PTO-1449 and copies of cited items, was filed 12/20/2000 along with the application filing papers. The 3/31/03 Office Action does not indicate that this IDS has been considered. It is requested that the 12/20/2000 IDS be acknowledged, the cited items considered, and the form PTO-1449 be initialed and made of record. If requested, the undersigned attorney can provide replacement copies of any of the items from the IDS.

X. Conclusion

Therefore it is submitted that Claims 20-38 are allowable and a Notice of Allowance is earnestly solicited.

Respectfully submitted,

Dated: July 30, 2003

By:   
John A. Rafter, Jr.  
Reg. No. 31,653

33451  
STOEL RIVES LLP  
900 SW Fifth Avenue, Suite 2600  
Portland, OR 97204-1268  
Telephone: (503) 224-3380  
Facsimile: (503) 220-2480